

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Appellant: CHENEVICH, et al.
Title: SYSTEM AND METHOD FOR STORING, CREATING, AND
ORGANIZING FINANCIAL INFORMATION ELECTRONICALLY
Appl. No.: 10/799,378
Filing Date: 3/12/2004
Examiner: Robert M. Timblin
Art Unit: 2167
Confirmation Number: 7289

REPLY BRIEF

Mail Stop Appeal Brief - Patents
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Sir/Madam:

This Reply Brief is being filed in response to an Examiner's Answer mailed November 13, 2009, rejecting Claims 1-3, 6-12, and 14. As a result, the submission of this Reply Brief under the provisions of 37 C.F.R. § 41.37 is timely filed. Although no fee is believed due, the Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Appellants respectfully request reconsideration of the Application.

REAL PARTY IN INTEREST

The real party in interest is U.S. Bank, National Association, the assignee of record, having a place of business at 800 Nicolet Mall, Minneapolis, Minnesota 55402 USA. The assignment to U.S. Bank, National Association was recorded in the records of the United States Patent and Trademark Office at Reel/Frame 023635/0695 on December 10, 2009.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellants or Appellant's patent representative.

STATUS OF CLAIMS

The present appeal is directed to Claims 1-3, 6-12, and 14, all of which stand rejected pursuant to a Final Office Action dated April 17, 2009. Claims 4, 5, 13 and 15-25 were canceled. Claims 1-3, 6-12, and 14 are being appealed. Claims 1-25 with the appropriate status reference are shown in the attached Claims Appendix.

STATUS OF AMENDMENTS

A Final Office Action dated April 17, 2009 was received by Appellants. A Response to the Final Office Action was electronically filed with the US Patent and Trademark Office on June 17, 2009. In the Response, Claim 6 was amended in response to an objection from the Examiner based on a claim dependency error and antecedent basis error which arose as an inadvertent error by Appellants due to cancellation of Claim 5 from which Claim 6 previously depended. In the Advisory Action dated June 29, 2009, the Examiner indicated that the Response was not entered.

A Notice of Appeal with a Pre-Appeal Brief was electronically filed with the US Patent and Trademark Office on July 17, 2009. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed September 24, 2009, in which the rejection of Claims 1-3, 6-12, and 14 was maintained. Thus, Claim 6 was amended subsequent to receipt of the Final Office Action dated April 17, 2009, but the amendment was not entered.

In the Pre-Appeal Brief filed July 17, 2009, Appellants amended Claim 6 merely to provide the requested antecedent basis. In the Advisory Action, the Examiner refused to enter the amendment stating that "automatic association with the created folder using pre-established criteria that includes merchant categories would require further search and/or consideration." However, this claim element was already considered in previous Claims 4 and 5 which were canceled. See Response filed September 28, 2007. Thus, the Examiner had already considered Claim 6 as amended and no new search or consideration was required. The amendment further placed the application in better form for appeal. Therefore, the claim amendment should have been entered. Nevertheless, Appellants are pursuing the present Appeal with Claim 6 in the form prior to the amendment that was not entered. Therefore, as included herein, no claims have been amended subsequent to receipt of the Final Office Action dated April 17, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

Two independent claims, Claims 1 and 10, are under appeal and separately argued below.

Claim 1 is directed to a method of storing, creating, and organizing financial information electronically. The method comprises:

establishing a communication session between a first system and a second system (e.g. 30, Fig. 3; pg. 8, ll. 11-13; pg. 8, ll. 26-28);

communicating information associated with a financial document from the second system to the first system the financial document associated with a first account (e.g. 36, Fig. 3; pg. 8, ll. 15-22);

receiving user selected filing preferences at the second system from the first system (e.g. 48, Fig. 3; pg. 9, ll. 3-7; pg. 10, ll. 30-31);

providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system (e.g. 14, 24, Fig. 2; 56, 57, Fig. 5; Fig. 11; pg. 7, ll. 21-26; pg. 9, ll. 2-3; pg. 12, ll. 6-26), the folder being one of a plurality of folders associated with the first account (e.g. pg. 8, ll. 1-8; pg. 9, ll. 2-10); and

to automatically and without human intervention associate the financial document with the created folder based on the received user selected filing preferences so that the financial document is included in the created folder in the online environment hosted at the second system (e.g. 80, 82, Fig. 8; pg. 9, ll. 3-9; pg. 10, ln. 28-pg. 11, ln. 14; pg. 13, ll. 1-7), wherein the online environment displays the financial document in the created folder (e.g. Fig. 14; Fig. 16; pg. 12, ll. 1-26).

Claim 10 is directed to a system for storing, creating, and organizing financial information associated electronically. The system comprises a host computer coupled to a network and configured to run programmed instructions to provide an on-line environment for a customer user at a customer user computer connectable to the network to organize, send, search, create, and save financial information using a hierarchy of folders defined by the customer user in the online environment hosted at the host computer (e.g. Figs. 10-14, and 16; pg. 8, ln. 11-pg. 9, ln. 10), wherein each folder in the hierarchy of folders includes a financial document that includes multiple indicators (e.g. Figs. 10, 14, and 16; pg. 12, ll. 12-18), wherein the financial document is automatically and without human intervention associated with a folder in the hierarchy of folders based on customer user selected filing

preferences received from the customer user computer (e.g. 80, 82, Fig. 8; pg. 9, ll. 3-9; pg. 10, ln. 28-pg. 11, ln. 14; pg. 13, ll. 1-7), wherein the host computer is configured to provide a search across folders (e.g. Fig. 14; Fig. 16; pg. 12, ll. 1-26).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Two grounds of rejection are presented for review in this appeal:

- (1) The rejection of Claims 1-3 and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0111946 to Fallon (*Fallon*) in view of U.S. Patent No. 7,146,367 to Shutt (*Shutt*) and further in view of U.S. Patent No. 6,859,212 to Kumar (*Kumar*); and
- (2) The rejection of Claims 10-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Fallon* in view of *Kumar*.

ARGUMENT

I. LEGAL STANDARDS

A. Standard under 35 U.S.C. 103(a)

35 U.S.C. 103(a) states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Obviousness under 35 U.S.C. 103(a) involves four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984).

According to M.P.E.P. § 2142,

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Similarly, according to M.P.E.P. § 2143, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."

According to M.P.E.P. § 706.02(j),

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made**.

****** "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Additionally, according to M.P.E.P. § 2141.02, "[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole."

II. REJECTION OF CLAIMS 1-3 and 6-9 UNDER 35 U.S.C. § 103(a)

On page 2 of the Final Office Action, Claims 1-3 and 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fallon* in view of *Shutt* and further in view of *Kumar*. For the reasons given below, Appellants submit that the Examiner's rejection of independent Claim 1 is improper and should be reversed.

Independent Claim 1, with emphasis added through underlining, recites in part:

receiving user selected filing preferences at the second system from the first system;

providing an online environment by the second system configured to ...

to automatically and without human intervention associate the financial document with the created folder based on the received user selected filing preferences so that the financial document is included in the created folder in the online environment hosted at the second system, wherein the online environment displays the financial document in the created folder.

On page 3 of the Final Office Action, the Examiner states:

With respect to claim 1, Fallon teaches

...

to automatically and without human intervention (0013) associate the financial document (0013, 0033; e.g. "however, only the user can move the information and/or documents into

the user's storage space) with the created folder so that the financial document (0033, 0081, and 0682) is included in the created folder in the online environment (0028, 0031) hosted at the second system (16) wherein the online environment (0028, 0031) displays the financial document (0033, 0081, and 0682) in the created folder (figures 4-7; i.e. documents are shown in their corresponding folders).

Appellants respectfully disagree.

At paragraph [0031] cited by the Examiner, *Fallon* states:

The inventive system preferably organizes the information into various categories as described below so that the user and/or an individual such as an executor who accesses the information after the death of the user can readily locate any particular informational item. The user can change, augment, or update the personal legacy plan at any time simply by accessing the Web site, entering identifying information, and accessing the stored information. The inventive system offers the user options to change, augment, or update the information. Thus the present invention offers the advantage that personal legacy information can be accessed and changed at any time and from virtually any location from which the user can access the World Wide Web. In certain embodiments the invention also notifies the user upon the occurrence of events that may warrant updating of the personal legacy plan.

At paragraph [0033] cited by the Examiner, *Fallon* states:

In certain preferred embodiments of the invention some of the documents and/or information such as medical records, financial records, tax returns, etc., may be provided by another party, herein referred to as a "contributor". Such a party may be, for example, a professional such as a physician, accountant, etc. (or an employee of such a professional). In preferred embodiments of the invention, the system provides each user with an electronic mailbox to which contributors can send documents and/or information. However, only the user can move the information and/or documents into the user's storage space.

(Underlining added). At paragraph [0203] of *Fallon* which discusses organizing the documents, *Fallon* states:

A major feature of certain preferred embodiments of the invention is the capacity to organize and integrate information of diverse types and obtained from a diverse array of sources. For example, in the preferred embodiments of the invention in

which the information and documents are organized as folders (FIG. 3), The invention is able, for example, to recognize when an item of information entered under one folder heading is also relevant to the contents of one or more of the other folders. For example, an individual's residential address in the Personal Folder may also be a real estate asset that may also be a secured liability in the Financial Folder with homeowners' insurance (Insurance Folder) and legal title (Legal Folder). The software of the invention integrates such information so that it is readily available across all folders. Thus in preferred embodiments of the invention, any information or document that is initially entered under a particular category in one of the folders is available in an appropriate category in one or more of the other folders.

(Underlining added). At paragraph [0213] *Fallon* further states:

The remainder of this section presents the architecture of the various folders and their integration in one embodiment of the invention in greater detail. As indicated below, the folders preferably contain information organized in a hierarchical fashion, and the software includes the capability to generate a variety of useful summaries based on the information contained in the folders. Certain information is indexed across folders. For example, the Personal Representatives and Advisors-Key Professionals sections under the Personal Folder, also appear in the Medical Folder, Financial Folder, and Legal Folder (and subfolders thereof) in their appropriate positions. It is to be understood that any particular implementation of the invention need not contain all the items indicated below and may contain additional items. This section also lists categories of relevant information and types of documents that may be found in each category.

(Underlining added). Thus, *Fallon* describes a system in which a user enters a document in a particular category in one of the folders, and the system makes the document available in the appropriate category of one or more other folder. *Fallon* also describes this process as indexing information across folders. The system described in *Fallon* provides for a fixed hierarchy of folders in which a user can store documents. (See Fig. 3-1). Thus, because the system of *Fallon* is fixed, the relationship between certain categories is known *a priori* so documents can be made available between the categories based on the known relationships. *Fallon*, however, fails to teach, suggest, or disclose “automatically and without human intervention associate[ing] the financial document with the created folder

based on the received user selected filing preferences” as recited in Claim 1. A financial document is only associated with a folder based on the fixed relationships between folders which is known *a priori*.

On page 8 of the Final Office Action, the Examiner states:

Examiner also wishes to note that Applicant's argument is further unpersuasive in that reciting automatic means to replace a manual activity is not sufficient to distinguish over the prior art. MPEP 2144.04 and *In re Venner*, 262 F.2d 91,95,120 USPQ 193, 194 (CCPA 1958).

Appellants respectfully disagree because the facts in *In re Venner* are sufficiently different from those in the present application such that M.P.E.P. § 2144.04 is inapplicable to the present claims. In *In re Venner*, the court found that the combination of two known structural elements, a known molding device with a middle core section that could be withdrawn and a known timing device to control the withdrawal at the appropriate time, to automate a process was not patentable. In contrast here, no cited reference provides any indication of how or even that the process that was previously performed based on the thought processes of the individual could be automated. Automating such a process is wholly different than automating a simple physical process. Therefore, *In re Venner* is not applicable.

On the Continuation Sheet of the Advisory Action, the Examiner states:

The Examiner respectfully disagrees and asserts that Fallon was relied upon to teach the automatic associating of the financial document with the created folder (see final Office Action dated 4/17/2009, page 3). Examiner further submits that Fallon teaches the claimed automatic association in paragraph 0031 wherein the system organizes [sic] the information into various categories (i.e. folders).

Examiner further maintains that Kumar explicitly [sic] teaches a user creating categories (which may be seen as folders) and a system that automatically organizes transactions (i.e. financial documents). As such, Examiner submits that Kumar teaches automatically filing transactions into created categories (i.e. folders) according to user preference.

(Underlining and bolding added). On page 4 of the Final Office Action, however, the Examiner states:

Fallon and Shutt do not appear to expressly recite receiving user selected filing preferences and **associating the financial document with the created folder based on the received user selected filing preferences.**

Kumar, however, teaches receiving user selected filing preferences (col. 39 line 14-15) at the second system from the first system and associating the financial document with the created folder based on the received user selected filing preferences (col. 39 line 8-17 and figures 18-20) for automatically categorizing financial information (i.e. transactions).

Appellants agree that *Fallon* and *Shutt* fail to teach, suggest, or describe “associate[ing] the financial document with the created folder based on the received user selected filing preferences” as recited in Claim 1. Appellants further respectfully submit that the Examiner’s contrary assertion in the Advisory Action is based on parsing the claim elements into parts. By doing so, the Examiner impermissibly considers the claim element admittedly not taught by *Fallon* and *Shutt* in isolation rather than the claim as a whole contrary to M.P.E.P. § 2141.02. Thus, the claim element is removed from its proper context. When taken out of context, the Examiner then asserts that *Kumar* provides the missing teaching. Appellants, however, respectfully disagree that *Fallon*, *Shutt*, or *Kumar* teaches “associat[ing] the financial document with the created folder based on the received user selected filing preferences” as recited in Claim 1 when the claim elements are considered in the proper context of the claim based on the plain language of the claim.

Kumar describes “a summary interface ... provided as part of a software suite for enabling viewing and manipulation of multiple categories of aggregated data compiled from a plurality of data sources and accessible through a single interfacing node”

(Abstract). At Column 39, lines 8-17 cited by the Examiner, *Kumar* states:

There are three functional links displayed on the face of interface 243. A Save Categories function 317 allows a user to

select categories related to specific accounts and save them to be accessed as new transactions occur. In one embodiment, a user may specifically create categories for certain types of transactions. When new transactions occur, they are automatically categorized according to user preference. In a preferred embodiment however, most transactions can be associated by default with one of the plurality of default categories available.

(Underlining added). Thus, *Kumar* describes sorting transactions into default categories or user created categories. *Kumar* does not teach anything whatsoever related to documents which the Examiner repeatedly associates with transactions. *Kumar* further does not teach anything whatsoever related to organizing the transactions into folders. Instead, Kumar describes associating a transaction with a category which the Examiner repeatedly associates with a folder. As shown in Fig. 21 of *Kumar* reproduced below, the categories are merely used to organize the display of the transactions within the transaction history.

Transaction Center: Transaction History / All Accounts - By Category; YTD

TRANSACTION HISTORY

Select an Account:

All Accounts
Chase Credit Card
American Express
BankOne Checking

Select a View:

By Category
Chronological
Auto
Charitable Contributions
Entertainment
Food and Beverage

Select a Timeframe:

YTD
This Month
Last 6 months
Last 12 months

Display

Transaction History: All Accounts					Chart
Date	Description	Category	Card	Amount	
01/05/00	Brake Repair Shop	Auto	Chase Mastercard	\$563.38	
03/04/00	Big O Tires	Auto	American Express	\$432.21	
Auto Total				\$995.75	
02/05/00	Pomona College	Charitable Contributions	First USA Card	\$100.00	
04/15/00	American Heart Association	Charitable Contributions	First USA Card	\$200.00	
Charitable Contributions Total				\$300.00	
01/03/00	The Fillmore	Entertainment	American Express	\$154.32	
02/04/00	Shoreline Amphitheater	Entertainment	Chase Mastercard	\$88.44	
03/05/00	TicketMaster	Entertainment	BankOne Checking	\$145.34	
04/31/00	Great American Music Hall	Entertainment	American Express	\$198.20	
Entertainment Total				\$586.30	
01/03/00	Final Final	Food and Beverage	Chase Mastercard	\$27.85	
04/07/00	Clematines	Food and Beverage	Chase Mastercard	\$187.67	
Food and Beverage Total				\$195.52	
01/03/00	Payment to Bob Formichi	Housing	BankOne Checking	\$1,800.00	
02/04/00	Payment to Bob Formichi	Housing	Chase Mastercard	\$800.00	
03/05/00	Payment to Bob Formichi	Housing	BankOne Checking	\$800.00	
04/31/00	Payment to Bob Formichi	Housing	American Express	\$800.00	
Housing Total				\$4,000.00	
Expenses YTD				\$6,667.39	

Edit Categories

Fig. 21

Kumar further states:

It is noted herein that a user may arbitrarily change a category associated with any line item by simply interacting with the drop-down menus such as menu 315, and selecting an alternate category. By selecting one of the basic categories, transactions are sorted and displayed according to that category. By selecting one of the subcategories associated with the basic category, transactions are sorted and displayed according to that subcategory.

(Col. 38, ll. 25-44; underlining and bolding added). Sorting and displaying a transaction in a transaction history based on a category code is clearly distinct from “associat[ing] the financial document with the created folder based on the received user selected filing preferences so that the financial document is included in the created folder in the online environment hosted at the second system” as recited in Claim 1.

On the Continuation Sheet of the Advisory Action, the Examiner further

states:

Applicant further provides a screenshot of Kumar's figure 21 and a paragraph relating to figure 18 (response, page 7) and then states "Sorting and displaying a transaction in a transaction history based on a category code is clearly distinct from "associating the financial document with the created folder based on the received user selected filing preferences ... " Examiner respectfully disagrees and maintains that Kumar teaches automatically filing according to user preferences (see above paragraph), which is required by the claim. Examiner further submits that sorting and displaying based on categories is a process that occurs after the transactions are filed into categories. In other words, according to Kumar, when new transactions occur, they are automatically categorized according to user preference (col. 39 lines 10-17). Thus, the transactions are first [automatically] associated with a category in order to be effectively sorted and displayed. Further, Examiner submits that selecting a view in Kumar's system (e.g. fig. 21 drawing reference 329) describes transactions in a folder. That is, for example, a user selecting a view based on "Entertainment" would be presented with a display according to the format dictated by the option selected (see Kumar, col. 40, lines 20-36). Thus, in this example, the "Entertainment" category serves as a folder for Entertainment transactions. Lastly, Examiner submits that one of ordinary skill in the art would recognize a category as a folder in that both effectively contain a group of files bearing a relationship. However, even if it can be persuasively argued that a category cannot be a folder, Examiner submits that the Shutt reference discloses [sic] this feature (e.g. Final Office Action, page 4).

Appellants respectfully disagree. A transaction is not a document, and a category is not a folder as the Examiner repeatedly indicates. First, a transaction as described in *Kumar* is not a document, but is merely the data associated with a transaction and not the document itself. For example, a transaction according to *Kumar* may be the amount and date of a check, but the transaction is not a document containing a copy of the check itself. Second, unlike a folder, a user cannot collapse or expand a list of transactions included in a category, and *Kumar* nowhere indicates that a category actually contains a group of transactions. Instead, a user assigns a category to a transaction as shown in Figs.

18-19 of *Kumar* cited by the Examiner. As shown in Fig. 20 of *Kumar*, the transaction history can be organized based on account, timeframe, and category. For example, as shown in Fig. 21 of *Kumar*, the transactions, which again are not documents, are merely grouped under a header defined by the category as a viewing option. Thus, *Kumar* merely presents a transaction history with the transactions organized based on the category to which the transaction was assigned. Again, *Kumar* provides no teaching whatsoever for organizing documents into folders based on user selected filing preferences which is a distinct functionality as shown in Figs. 11-14 of the present invention. Therefore, *Kumar* also fails to teach, suggest, or disclose "associat[ing] the financial document with the created folder based on the received user selected filing preferences so that the financial document is included in the created folder in the online environment hosted at the second system" as recited in Claim 1.

On page 13 of the Examiner's Answer, the Examiner further states:

i) Examiner submits that a transaction can be seen as the claimed "financial document". Specifically, a transaction in view of *Kumar* is seen as a history of financial interaction with a banking system (e.g. see *Kumar*, abstract). In other words, *Kumar*'s transaction is a record of interaction with a bank and thus a document. Thus, Appellant's assertion that "a transaction may be the amount and date of a check, but the transaction is not a document containing a copy of the check itself" may still readily be seen as a record (thus document) of the processing of the check.

Appellants respectfully disagree. According to *Kumar* and as the Examiner seems to recognize, the transaction is not itself a document, but a record stored in a database. For example, *Kumar* states:

DBRE [database-reporting engine] 155 acts as a first "gathering agent" and checks repository 157 first for user requested data upon request. User-history records of all user transactions at all of his registered WEB-based services are preferably maintained in repository 157 and are accessible to DBRE 155. In some cases, services such as those represented by servers 141-145 may provided complete

transaction histories that may be obtained and stored in repository 157 and updated periodically.

(Col. 24, ll. 45-53; underlining and bolding added). *Kumar* further states that “[r]epository 157 may be assumed to support varied database programs as may be required to manipulate and organize data or metadata stored therein.” (Col. 22, ll. 60-62). Therefore, the transaction, as described by *Kumar* to be data stored in a database, cannot be considered to be a document.

On page 14 of the Examiner’s Answer, the Examiner further states:

As such, because Kumar’s transactions can be seen as data files (or, records of interaction), evidence (of financial interaction), or a non-executable file containing data for use by, in the case of Kumar, a banking application, Kumar’s transactions can be seen as the same as the claimed “document”.

Again, Appellants respectfully disagree. First, Appellants disagree that the dictionaries cited by the Examiner are applicable. In particular, Appellants respectfully submit that the definition, “[s]omething, such as a recording or a photograph, that can be used to furnish evidence or information” (pg. 13, Examiner’s Answer), is not relevant to the term “document” as used in the claims. Second, *Kumar*’s transaction cannot be seen as data files or a non-executable file because records in a database are not themselves data files or non-executable files.

On page 14 of the Examiner’s Answer, the Examiner further states:

Next, Appellant states that “unlike a folder, a user cannot collapse or expand a list of transactions included in a category, and Kumar nowhere indicates that a category actually contains a group of transactions” (Brief, page 13, last paragraph). Examiner respectfully disagrees because in Kumar, figure 13, a user is able to display transactions categorized to associated accounts (see also Kumar, col. 32 lines 50-56; therein an account is a category of transactions). Thus, by a user selecting an account (drawing reference 247), the associated transactions are displayed (drawing reference 249). In other words, when the account (or category) is selected an expanded list of transactions is displayed. Furthermore,

because the selected account (i.e. category) includes the transactions displayed, the account (i.e. category) is seen as a folder.

Again, Appellants respectfully disagree with the Examiner's characterization. Appellants respectfully submit that Fig. 13 merely shows a drop down box that allows the user to change the category to which the transaction is assigned. The transactions can then be grouped under a header associated with the selected category as shown with reference to Fig. 21.

Therefore, *Fallon*, *Shutt*, and *Kumar*, alone and in combination, fail to teach, suggest, or describe, all of the claim elements as recited in Claim 1. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 1-3 and 6-9.

III. REJECTION OF CLAIMS 10-12 and 14 UNDER 35 U.S.C. § 103(a)

On page 6 of the Final Office Action, Claims 10-12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fallon* in view of *Kumar*. For the reasons given below, Appellants submit that the Examiner's rejection of independent Claim 10 is improper and should be reversed.

Independent Claim 10, with emphasis added through underlining, recites in part:

an on-line environment for a customer user at a customer user computer connectable to the network to organize, send, search, create, and save financial information using a hierarchy of folders defined by the customer user in the online environment hosted at the host computer, wherein each folder in the hierarchy of folders includes a financial document that includes multiple indicators, wherein the financial document is automatically and without human intervention associated with a folder in the hierarchy of folders based on customer user selected filing preferences received from the customer user computer, wherein the host computer is configured to provide a search across folders.

On page 6 of the Final Office Action, the Examiner states:

With respect to claim 10, Fallon teaches ...:

a host computer (12) coupled to a network (fig. 1) and running programmed instructions to provide an on-line environment (0028, 0031) for a customer user (0028; i.e. the term "user") at a customer user computer (16) connectable to the network (fig. 1) to organize, send, search, create, and save financial information (0033, 0081, and 0682) using a hierarchy of folders (0169) defined by the customer user (0028 and 0033; i.e. the term "user") in the online environment (0028, 0031) hosted at the host computer (12), wherein each folder in the hierarchy of folders (fig. 6) includes a financial document (0033, 0081, and 0682) that includes multiple indicators (0047), wherein the financial document (0033, 0081, and 0682) is automatically and without human intervention (0013) associated with a folder (0203) in the hierarchy of folders (0169), wherein the host computer (12) is configured to provide a search across folders (0183-0184).

(Underlining added). At paragraph [0028] cited by the Examiner, *Fallon* states:

The invention assists a user in the development of a personal legacy plan that is stored on a computer-readable medium located at a secure central site removed from the user's own location. The invention includes computer software (i.e., computer-executable process steps stored on a computer-readable medium) that assist the user in the development of the plan, store information (preferably including documents) that form components of the plan, and provide access on a selective basis to the components of the plan. The invention thus provides a personal legacy and personal information organizer and storage space for a user. As used herein, the term "user" refers to an individual who utilizes the inventive system to develop a personal legacy plan. The term "personal legacy plan" is used broadly herein. A personal legacy plan may encompass documents and information that are traditional components of an estate plan but may also encompass a range of other documents and information that are not traditionally found in an estate plan. A personal legacy plan, as used herein, can include both informational fact-based data and also personal "items" that reflect an individual's personal, subjective experience. The informational, fact-based data may, for example, be stored in legal, medical, financial, and personal folders as further described below. The personal items may be described as the distillation of the important events and things in a person's life, e.g., events and things that one wants to preserve for one's children and for future generations. The personal items can include anything that can

be digitized, e.g., journals, photos, videos, ethical will, letters, etc.

(Underlining added). At paragraph [0033] cited by the Examiner, *Fallon* states:

In certain preferred embodiments of the invention some of the documents and/or information such as medical records, financial records, tax returns, etc., may be provided by another party, herein referred to as a "contributor". Such a party may be, for example, a professional such as a physician, accountant, etc. (or an employee of such a professional). In preferred embodiments of the invention, the system provides each user with an electronic mailbox to which contributors can send documents and/or information. However, only the user can move the information and/or documents into the user's storage space.

(Underlining added). Thus, *Fallon* fails to provide any teaching whatsoever related to "a hierarchy of folders defined by the customer user in the online environment hosted at the host computer" (underlining added) as recited in Claim 10. Instead, *Fallon* describes a system which includes a fixed set of folders that are defined *a priori* and not by the customer user.

At paragraphs [0183]-[0184] cited by the Examiner, *Fallon* states:

In certain embodiments of the invention information submitted by users is stored in one or more databases, which may be implemented in a variety of ways. For example, some of the data may be stored in a relational database referred to as the personal legacy information database, containing multiple data tables. In certain embodiments of the invention the database uses Structured Query Language (SQL). SQL allows users to define, access, and manipulate data in a wide range of relational database management systems, such as Oracle, Sybase, Informix, Microsoft Access, and others. It should be understood that the data may be stored in separate databases, including databases accessible over a data communications network, and that other types of databases (e.g., object-oriented databases) could be used in the invention. However, for purposes of description it will be assumed that the data are stored in a relational database in multiple tables.

Thus in certain embodiments of the invention the personal legacy information database is an SQL database consisting of a set of tables, each of which consists of multiple records containing fields in which data is stored. One field in each

record (or a combination of fields) constitutes a key, i.e., an item (or items) of data that uniquely identifies that record. (Note that the term "key" is used here in a different sense to a private or public key for encryption/decryption purposes.) A suitable key is a user's social security number. The tables may include, but are not limited to: a basic personal information table, a legal records table, a financial records table, a tax records table, an insurance policy table, a health/medical records table, an employment history table, a security items table, a certificate/other records table, and a personal items table. Of course any convenient selection of tables and any approach to organization of the informational items is within the scope of the invention. The fields in each table correspond to information items. For example, the basic personal information table may contain fields such as: name, address, telephone number, social security number, etc. In preferred embodiments of the invention the tables will also contain standard fields such as creation time stamp, update time stamp, archive time stamp, and various status flags. In the case of documents that are uploaded by the user and stored by the inventive system, instead of containing the documents themselves the tables preferably contain information that allows the stored documents to be identified and accessed (e.g., an address location, storage location, etc.).

(Underlining added). Thus, *Fallon* describes a set of tables defined in a database without even mentioning the term "search." *Fallon*, in fact, fails to provide any teaching whatsoever related to a search functionality. Thus, *Fallon* fails to provide any teaching whatsoever related to a "host computer ... configured to provide a search across folders" as recited in Claim 10.

On page 7 of the Final Office Action, the Examiner further states:

Fallon does not appear to expressly teach [associating the financial document with a folder] based on customer user selected filing preferences received from the customer computer.

Kumar, however, teaches teach [sic] [associating the financial document with a folder] based on customer user selected filing preferences (col. 39 line 14-15) received from the customer computer (col. 39 line 8-17 and figures 18-20) for automatically categorizing financial information (i.e. transactions).

Appellants agree that *Fallon* fails to teach, suggest, or describe a "financial document ... associated with a folder in the hierarchy of folders based on customer user

selected filing preferences received from the customer user computer” as recited in Claim 10. Appellants, however, respectfully disagree that *Kumar* provides the missing teaching.

As discussed in Section II. above, *Kumar* describes “a summary interface ... provided as part of a software suite for enabling viewing and manipulation of multiple categories of aggregated data compiled from a plurality of data sources and accessible through a single interfacing node” (Abstract). At Column 39, lines 8-17 again cited by the Examiner, *Kumar* states:

There are three functional links displayed on the face of interface 243. A Save Categories function 317 allows a user to select categories related to specific accounts and save them to be accessed as new transactions occur. In one embodiment, a user may specifically create categories for certain types of transactions. When new transactions occur, they are automatically categorized according to user preference. In a preferred embodiment however, most transactions can be associated by default with one of the plurality of default categories available.

(Underlining added). Thus, *Kumar* describes sorting transactions based on default categories or user created categories. *Kumar* does not teach anything whatsoever related to documents. *Kumar* further does not teach anything whatsoever related to organizing the transactions into folders. As shown in Fig. 21 of *Kumar*, the categories are merely used to organize the display of the transactions within the transaction history. Sorting and displaying a transaction in a transaction history based on a category code is clearly distinct from a “financial document ... automatically and without human intervention associated with a folder in the hierarchy of folders based on customer user selected filing preferences received from the customer user computer” as recited in Claim 10. A transaction is not a document, and a category is not a folder as the Examiner repeatedly indicates as further discussed in Section II. above. Therefore, *Kumar* fails to teach, suggest, or disclose a “financial document ... associated with a folder in the hierarchy of folders based on

customer user selected filing preferences received from the customer user computer” as recited in Claim 10.

Therefore, *Fallon* and *Kumar*, alone and in combination, fail to teach, suggest, or describe, all of the claim elements as recited in Claim 10. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 10-12 and 14.

CONCLUSION

In view of the foregoing discussion and arguments, Appellants respectfully submit that Claims 1-3 and 6-9 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fallon* in view of *Shutt* and *Kumar* and that Claims 10-12 and 14 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fallon* in view of *Kumar*. Accordingly, Appellants respectfully request that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Previously Presented, rejected) A method of storing, creating, and organizing financial information electronically, the method comprising:
 - establishing a communication session between a first system and a second system;
 - communicating information associated with a financial document from the second system to the first system the financial document associated with a first account;
 - receiving user selected filing preferences at the second system from the first system;
 - providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system, the folder being one of a plurality of folders associated with the first account; and
 - to automatically and without human intervention associate the financial document with the created folder based on the received user selected filing preferences so that the financial document is included in the created folder in the online environment hosted at the second system, wherein the online environment displays the financial document in the created folder.
2. (Previously Presented, rejected) The method of claim 1, wherein the financial document includes credit card payments, debit card transactions, imaged checks, electronic bill payments or account statements.
3. (Previously Presented, rejected) The method of claim 1, wherein associating the financial document with the created folder is performed based on instructions from the customer user when the financial document is viewed.
4. (Canceled).
5. (Canceled).
6. (Previously Presented, rejected) The method of claim 1, wherein the pre-established criteria includes merchant categories.

7. (Previously Presented, rejected) The method of claim 1, wherein the online environment is further configured to allow the customer user at the first system to retrieve documents based on a document storage time stamp, date last accessed, date posted, dollar amount, group, or category.

8. (Original, rejected) The method of claim 1, further comprising communicating financial information from a third system to the first system corresponding to the first account, wherein the third system and the second system contain separate and distinct accounts associated with the customer user.

9. (Original, rejected) The method of claim 1, further comprising providing each of the plurality of folders with a public or private indication, the folders indicated as public being accessible by persons having a shared key given them by the customer user.

10. (Previously Presented, rejected) A system for storing, creating, and organizing financial information associated electronically, the system comprising:

a host computer coupled to a network and configured to run programmed instructions to provide an on-line environment for a customer user at a customer user computer connectable to the network to organize, send, search, create, and save financial information using a hierarchy of folders defined by the customer user in the online environment hosted at the host computer, wherein each folder in the hierarchy of folders includes a financial document that includes multiple indicators, wherein the financial document is automatically and without human intervention associated with a folder in the hierarchy of folders based on customer user selected filing preferences received from the customer user computer, wherein the host computer is configured to provide a search across folders.

11. (Previously Presented, rejected) The system of claim 10, wherein the financial document includes credit card payments, debit card transactions, imaged checks, electronic bill payments or account statements.

12. (Previously Presented, rejected) The system of claim 10, wherein the financial document is associated with a folder based on instructions from the customer user when the financial information is viewed.

13. (Canceled).

14. (Previously Presented, rejected) The system of claim 10, wherein the multiple indicators include document storage time stamp, date last accessed, date posted, dollar amount, group, or category.

15.-25. (Canceled).

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.